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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): STL10198/40046.162USU1

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on February 1, 2006

Signature Diana C Anderson

Typed or printed name Diana C. Anderson

Application Number	Filed
09/982,366	October 17, 2001

First Named Inventor: Serge Jacques Fayeulle

Art Unit	Examiner
2651	Fred Tzeng

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____
- [X] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 38,794

Signature

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2/1/2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 forms are submitted.

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PATENT
Dkt. STL10198/40046.162USU1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Serge Jacques Fayeulle**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **09/982,366** Group Art: **2651**
Filed: **October 17, 2001** Examiner: **Fred Tzeng**
For: **MULTI-PHASE ACCELERATION OF A DATA STORAGE DISC**

Mail Stop AF
Commissioner for Patents
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APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Please enter the following remarks as Applicant's basis for this Pre-Appeal Brief Request for Review.

IT IS CLEAR ERROR THAT THE EXAMINER HAS REPEATEDLY REFUSED TO SUBSTANTIATE A PRIMA FACIE CASE OF ANTICIPATION

Following are indisputable facts from the record:

1. There are three independent claims 1, 13, and 25.

2. Method and apparatus claims 1 and 25, respectively, explicitly recite two acceleration rates.

3. Apparatus claims 13 and 25 explicitly recite a landing zone.

In making a rejection final, the Examiner's obligation is clear: "shall repeat or state all grounds of rejection...clearly stating the reasons in support thereof." MPEP 706.07. The grounds "must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal...." *Id.* Furthermore, "The examiner should never lose sight of

the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." *Id.*

This MPEP provision is entitled "Examination of Applications," and defines when an examination can properly result in a final rejection. Applicant submits that an Office Action, in and of itself, does not manifest that an "examination" has taken place if the Examiner's action can be shown to be incomplete for having not considered the patentability of the invention as claimed. 37 CFR 1.104(a). In this case, Applicant submits that an objective review of the record will readily conclude that the Examiner has improperly closed the merits without developing any issue for appeal. Applicant further prays that from such objective review the Panel will agree that the Examiner's legal error and refusal to substantiate the anticipatory rejection of any of the independent claims is not contemplated by the MPEP as an appropriate basis for closing the merits.

Claims 1 and 25

In the first action claims 1 and 25 were rejected as being anticipated by Boutaghou '222 (Office Action of 5/5/2004). Applicant rebutted that Boutaghou '222 does not identically disclose the *first acceleration rate* and *second acceleration rate* of claim 1, and similarly does not identically disclose the *multiple acceleration rates* of claim 25. (Applicant's Response of 8/5/2004, pg. 8)

The Examiner curiously then began a mischaracterization of Boutaghou '222 from which he has steadfastly refused to retreat. In response to Applicant's arguments, the Examiner stated: "In column 4 lines 2-9, Boutaghou teaches accelerating the disc rotation velocity from the slower first velocities to the second faster velocity by acceleration rate or rates." (Office Action of 11/1/2005 para. 5, emphasis added) The Examiner thus made the rejection final, further relying on Boutaghou '222 col. 9 lines 9-20 and lines 17-25 as disclosing the *first acceleration rate* and the *second acceleration rate* of the present embodiments as claimed.

Applicant rebutted the final rejection by reiterating that Boutaghou '222 is wholly silent regarding any acceleration methodology employed to obtain a desired velocity. (Applicant's Response of 1/3/2006, pg. 9-10 and 13-14) In fact, neither "accelerate" nor "acceleration" is used in Boutaghou '222. The Examiner's substitution of Boutaghou '222's two velocities for the claimed two accelerations is at best a misunderstanding of the

difference between acceleration and velocity, or at worst an unjust subterfuge used to improperly close the merits without substantiating an anticipatory rejection.

At any rate, it is unjust to require Applicant now to prepare an appeal brief to explain that velocity is different than acceleration. Rather, Applicant is entitled to a reopening of the merits in order that the grounds upon which these claims are rejected can be clarified in order to develop an appealable issue. MPEP 706.07

This case is not in condition for appeal due to the unresolved factual issue that the Examiner has not substantiated a prima facie case of anticipation because the cited reference does not identically disclose all the features of the rejected claims. Applicant now prays for an objective review of the factual and legal deficiencies of these rejections in order to withdraw them.

Claims 13 and 25

In the first action claim 13 was likewise rejected as being anticipated by Boutaghou '222 (Office Action of 5/5/2004). Applicant rebutted that Boutaghou '222 does not identically disclose the *landing zone* as in the present embodiments as claimed. (Applicant's Response of 8/5/2004, pg. 8)

The Examiner then curiously admitted that the cited reference does not identically disclose all the recited features of the rejected claim, but nevertheless maintained the anticipatory rejection: "A ramp may not be identical to a landing zone, but it is certainly functioned [sic] as a landing zone for a transducer to land on for parking." (Office Action of 11/1/2005, para. 5, emphasis added) The Examiner thus made the rejection final, further relying on the same passages of Boutaghou '222 as above.

Applicant rebutted the final rejection by reiterating that Boutaghou '222 is wholly silent regarding using a *landing zone*, both in terms of the ordinary meaning and the broadest reasonable meaning of the claim term *landing zone* to a skilled artisan. (Applicant's Response of 1/3/2006, pg. 11-13) Particularly, the skilled artisan readily understands the specification discloses a contact-start-stop (CSS) type data storage device, making a load/unload ramp as in Boutaghou '222 superfluous. Further, the Examiner's argument that a non-identical structure with some alleged similarity in function can be used to substantiate an anticipatory rejection is a misplaced notion of the law. *C.R. Bard, Inc. v. M3 Systems, Inc.* 48 USPQ2d

1225 (Fed. Cir. 1998); *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). (see Applicant's Response of 1/3/2006, pg. 11).

In fact, Boutaghou '222 discloses using a load/unload ramp precisely to overcome problems allegedly associated with the presently contemplated CSS devices: "To overcome the stiction problem and to provide for a much more rugged design for disk drives used in mobile computers, such as portable computers and notebook computers, disk drive designers began unloading the sliders onto a ramp positioned on the edge of the disk." (Boutaghou '222, col. 2 line 58-62) The Examiner's substitution of Boutaghou '222's load/unload ramp for the claimed *landing zone* is likewise at best a misunderstanding of the structural and functional differences between the two, or at worst an unjust subterfuge used to improperly proceed without substantiating an anticipatory rejection.

At any rate, it is unjust to require Applicant now to prepare an appeal brief to explain that a landing zone is different than a load/unload ramp, especially where the Examiner has admitted that they are not identical. Rather, Applicant is entitled to a reopening of the merits in order that the grounds upon which these claims are rejected can be clarified in order to develop an appealable issue. MPEP 706.07

This case is not in condition for appeal due to the unresolved legal issue that the final rejection is clearly not proper and without basis because there is no basis in the law for the Examiner's anticipatory rejection, because he admits the cited reference does not identically disclose all the features of the rejected claim. This case is also not in condition for appeal due to the unresolved factual issue that the Examiner has not substantiated a *prima facie* case of anticipation because the cited reference does not identically disclose all the features of the rejected claims. Applicant now prays for an objective review of the factual and legal deficiencies of these rejections and withdrawal of the same.

Conclusion

Accordingly, for at least these reasons the Applicant believes this case is not in condition for appeal. Withdrawal of the final rejection of all claims for further prosecution on the merits to completion is respectfully requested.

Respectfully submitted,

By: _____

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